

Invention III is allegedly drawn to a product (*i.e.*, computer program). It is noted that restriction is only proper when: (1) each invention as claimed is independent or distinct, and (2) there would be a serious burden on the examiner if restriction were not required. See MPEP §§ 803, 808. Applicant respectfully submits that Examiner has failed to show distinctness or a serious burden.

The Examiner asserts that Inventions III and I/II are related as product and process of use. The Examiner asserts that the inventions are patentably distinct because "the process for using the product as claimed can be practiced with another materially different product, such as those set forth in the background of the specification (see page 1+)". Applicant respectfully disagrees.

Applicant initially submits that the above-noted statement by the Examiner fails to even allege distinctness between Inventions II and III. In fact, by the Examiner's own definition of the inventions, Invention II and Invention III cannot be related as a product and process of use. To the contrary, the Examiner defines Invention II as an *apparatus* and Invention III as a *product*, but does not define either as a *process of use*. Therefore, it is impossible for Invention II and Invention III to be related as a product and a process of use. Therefore, the Examiner has failed to show distinctness between Inventions II and III, and the restriction is improper.

Regarding Inventions I and III, it is further noted that a product and a process of using the product can be shown to be distinct inventions if either or both of the following can be shown: (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process. The burden is on the examiner to provide an example, but the

example need not be documented. See MPEP § 806.05(h), upon which the Examiner relies. Applicant submits that the Examiner has not shown that Inventions I and III are independent or distinct.

In fact, the Examiner has not provided an example of the process as claimed being used with another materially different product. The Examiner proffers as an example: "such as those set forth in the background of the specification". Applicant submits that this does not constitute a reasonable example. Rather, the Examiner has vaguely alluded to a portion of the instant specification, without explaining what product the example comprises. As such, it is impossible for Applicant to know what the Examiner is referring to, and therefore impossible to attempt to prove or provide a convincing argument that the alternative use suggested by the Examiner cannot be accomplished. The Examiner is reminded of the language of MPEP § 806.05(h), which states:

If the applicant either proves or provides a convincing argument that the alternative use suggested by the examiner cannot be accomplished, the burden is on the examiner to support a viable alternative use or withdraw the requirement.

Thus, it is clear that the Examiner must provide a clear and concrete example so that Applicant may at least have a chance to prove or provide a convincing argument to the contrary. Applicant submits that, in this case, the Examiner has failed to provide such an example. Therefore, the Examiner has failed to prove distinctness, and the restriction is improper and should be withdrawn.

The Examiner asserts that Inventions II and I are related as process and apparatus for its practice. The Examiner asserts that "the process as claimed can be

practiced by another and materially different apparatus such as by hand (*i.e.*, without the aid of a computer)". Applicant respectfully disagrees.

It is noted that a process and apparatus for its practice can be shown to be distinct if the process as claimed can be practiced by another materially different apparatus or by hand. The burden is on the examiner to provide reasonable examples that recite material differences. See MPEP §806.05(e), upon which the Examiner relies. In particular, the Examiner asserts the process of Invention I can be practiced without the aid of a computer.

Applicant submits that claim 1 appears to contradict the Examiner's assertion. In relevant parts, Applicant's independent claim 1 recites, *inter alia*, "A method for **computer-assisted** determination ...", "...the method comprising: **computer generating** a defined matrix...", and "...searching, with a **computer-assisted** geometric search procedure..." (emphasis added). Because the Examiner has failed to provide any other examples of material differences between Inventions I and II, Applicant submits that this basis of restriction is improper and should be withdrawn.

Moreover, Applicant submits that the restriction requirement set forth by the Examiner omits "an appropriate explanation" as to the existence of a "serious burden" if the restriction were not required. See MPEP § 803. By virtue of the Examiner's requirement and because the claims of the various inventions are so closely related, it is submitted that there is no serious burden on the Examiner in examining all claims together. In fact, all of the claims of Invention III (*i.e.*, claims 6 and 14) depend from claims of Invention II, and therefore, by definition, contain the same features. Thus, the

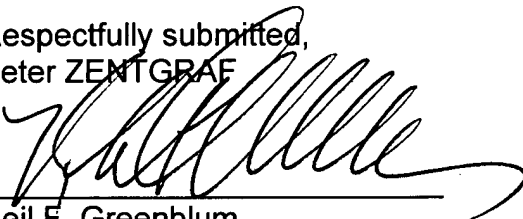
search for all of the claims includes a considerable amount of overlap. Therefore, no serious burden would come to bear on the Examiner by examining claims 1-14 together.

For the above reasons, and consistent with Office policy as set forth in the MPEP, Applicant respectfully requests that the Examiner reconsider the position taken in the above-mentioned Office Action and withdraw the restriction requirement in the present application. Accordingly, the Examiner's restriction requirement is believed to be improper and has been traversed for the reasons set forth above.

Nevertheless, in order to be fully responsive, Applicant has elected with traverse the invention defined by the Examiner as Invention I, in the event that the Examiner chooses not to reconsider and withdraw the restriction requirement.

Accordingly, Applicant respectfully requests that the restriction requirement be withdrawn and claims 1-14 be examined on the merits.

Respectfully submitted,  
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